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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/547,664	04/12/2000	Geoffrey B. Rhoads	60156	6242
23735	7590	12/03/2004	EXAMINER	
DIGIMARC CORPORATION 9405 SW GEMINI DRIVE BEAVERTON, OR 97008			VU, VIET DUY	
			ART UNIT	PAPER NUMBER
			2154	

DATE MAILED: 12/03/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

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Office Action Summary

Application No.

09/547,664

Applicant(s)

RHOADS ET AL.

Examiner

Viet Vu

Art Unit

2154

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 October 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 7-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 7-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. _____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application (PTO-152)
- 6) ☐ Other: _____

1. In view of the Appeal Brief filed on 10/12/04, PROSECUTION IS HEREBY REOPENED. New grounds of rejection are set forth below.

To avoid abandonment of the application, appellant must exercise one of the following two options:

(1) file a reply under 37 CFR 1.111 (if this Office action is non-final) or a reply under 37 CFR 1.113 (if this Office action is final); or,

(2) request reinstatement of the appeal.

If reinstatement of the appeal is requested, such request must be accompanied by a supplemental appeal brief, but no new amendments, affidavits (37 CFR 1.130, 1.131 or 1.132) or other evidence are permitted. See 37 CFR 1.193(b)(2).

2. The texts of 35 USC 102(e) and 103(a) not cited here can be found in the previous office action.

3. Claims 13-16 are rejected under 35 U.S.C. § 102(e) as being clearly anticipated by Moskowitz et al, U.S. pat. No. 5,822,432.

Moskowitz discloses a system utilizing watermark data for initiate data delivery/downloading comprising:

a program on a client computer for sending watermark data (e.g., service agreement, URLs) to a remote computer for

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initiating data delivery or content downloading from the remote computer to the client via a network (see col 9, lines 17-40).

It is noted that the downloaded data would include any typical content including audio, video, advertisement, software programs, etc.

4. Claims 7-16 are rejected under 35 U.S.C. § 103(a) as being unpatentable over Doyle et al, U.S. pat. No. 5,838,906, in view of Moskowitz.

Per claims 7-8 and 10-11, Doyle discloses a system for embedding a tag within a html document wherein the tag is indicative of a file context or format or a program identifier, i.e., identifying a program for use to open or operate upon the document at the remote system (see col 12, line 54 - col 13, line 31).

It is noted that a file is sent from a server to a client browser (e.g. in response to a client request) via the Internet in form of packets having at least client IP address (see col 9, lines 15-45).

Doyle does not teach using watermark data in the document. The use of watermark data in a file for enabling transfer of copyrighted document is well known in the art as disclosed by Moskowitz. Such prior art system comprises at least a watermark

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detector and a watermark related program for sending and retrieving watermark data (see Moskowitz's col 8, lines 54-65).

It would have been obvious to one of ordinary skill in the art at the time the invention was made to utilize watermark data in Doyle with because it would have enabled distributing copyrighted contents to a plurality of users in the network.

Per claims 9 and 12, Doyle teaches a router or program launcher for directing document data retrieved from the received packet to one of the data handlers for processing the data (see Doyle's col 14, lines 64-67 and fig. 8A).

Per claims 13-16, Moskowitz also teaches sending watermark data (e.g., URLs) to a remote computer for initiating data delivery or content downloading from the remote computer to the client via a network (see Moskowitz's col 9, lines 17-40). It would have been obvious to one skilled in the art to recognize that delivered data would have included any typical web contents including audio, video, advertisement, software programs, etc.

Response to Arguments:

5. Applicant's arguments filed on 10/12/04 with respect to claims 7-12 have been fully considered but are moot in view of new ground of rejection set forth above.

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Per claims 13-16, Applicant alleges that Moskowitz fails to teach using watermark data to initiate delivery of data to the client.

The examiner disagrees. Moskowitz clearly teaches using watermark data such as embedded URLs, once activated by client, would trigger a request for delivering or downloading data content to the client browser (see col 9, lines 37-40).

Conclusion:

6. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Viet Vu whose telephone number is 571-272-3977. The examiner can normally be reached on Monday through Friday from 8:00am to 4:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, John Follansbee, can be reached on 571-272-3964.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the Group receptionist whose telephone number is (703) 305-9600.



VIET D. VU
PRIMARY EXAMINER